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APR 27 2005

**OFFICE OF PETITIONS**

In re Application of  
Greenwood et al.  
Application No. 09/834,101  
Filed: April 12, 2001  
Attorney Docket No. MHG-05

Decision on Petition

This a decision on the petition under 37 CFR 1.137(b), filed October 22, 2004, to revive the above-identified application. The petition will also be treated as a petition under 37 CFR 1.181 to withdraw the holding of abandonment of the above-identified application.

The petition under 37 CFR 1.181 to withdraw the holding of abandonment is **dismissed**.

The petition under 37 CFR 1.137(b) is **dismissed**.

Background

35 U.S.C. 121 states, "If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions."

37 CFR. 1.142 states, "If two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted."

Section 808.01 of the Manual of Patent Examination Procedure ("MPEP") states, "Election of species should be required prior to a search on the merits . . . in all applications containing claims to a plurality of species with no generic claims."

The examiner determined that two or more independent and distinct inventions were being claimed in the instant application. Specifically, the examiner determined the application claimed several species and no generic claim. The examiner mailed a non-final Office action on September 25, 2003, requiring applicant to elect an invention to which the claims would be restricted.

The Office action listed ten species of the invention and four sub-species. The Office action stated, "Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution to which the claims shall be restricted if no general claim is finally held to be allowable. Currently no claim is generic."

The Office action warned applicant that a reply would be considered both nonresponsive and incomplete unless it was accompanied by an election. The Office action stated, "An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election." The Office action stated, "Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed."

One may request reconsideration and withdrawal of a restriction requirement. 37 CFR 1.143 states, "If [an] applicant disagrees with the requirement for restriction, he may request

reconsideration and withdrawal or modification of the requirement, giving the reasons therefor.” Although 37 CFR 1.143 allows one to traverse a restriction requirement, it does not absolve one of making a provisional election. Per 37 CFR 1.143, “In requesting reconsideration the applicant must indicate a provisional election of one invention for prosecution, which invention shall be the one elected in the event the requirement becomes final.”

If an applicant traverses the restriction requirement and the examiner mails a final requirement for restriction, a petition for review of the restriction requirement may be filed. Per 37 CFR 1.146, “After a final requirement for restriction, the applicant . . . may petition the Director to review the requirement. . . . A petition will not be considered if reconsideration of the requirement was not requested.”

On October 20, 2003, petitioner filed a petition entitled, “Petition to the Director Under 37 CFR §181 Requesting Withdrawal Of, or Relief From, Examiner’s Species Election Requirement.” The petition sought reconsideration and withdrawal of the restriction requirement. In the alternative, petitioner requested modification of the restriction requirement. The proposed modification placed the claims into four groups. Petitioner stated that, if the modification was adopted, petitioner elected the first group of claims. An applicant may request withdrawal or modification of a restriction requirement. Specifically, 37 CFR 1.143 allows one to seek, “reconsideration and withdrawal or modification of the [restriction] requirement.” However, the request must be accompanied by a provisional election. Petitioner did not indicate a provisional election of any of the species or subspecies given by the examiner.

The petition was reviewed by a Director for Technology Center 1700. A decision dismissing the petition was mailed on August 19, 2004. The decision noted that a request for reconsideration of a restriction requirement must be accompanied by a provisional election. The decision noted that, in order for a petition to review a restriction requirement to be timely, it must be filed after a final requirement for restriction has been made. See 37 CFR 1.146. The decision stated, “Applicant has not filed a response to the Examiner’s species election requirement nor has Applicant received a final requirement for restriction from the examiner.”

A Notice of Abandonment was mailed on October 4, 2004.

#### The petition under 37 CFR 1.181

Petitioner contends the application is not abandoned.

Petitioner contends the provisions of 37 CFR 1.143 do not apply to the situation when an examiner requires an election of species. The requirement for an election of species is a type of restriction requirement. MPEP 802.02 states, “Restriction, a generic term, includes . . . election of species.” The provisions of 37 CFR 1.143 apply when a requirement for restriction is mailed by the examiner. Therefore, the requirement for a provisional election stated in 37 CFR 1.143 applies to the instant application.

Petitioner contends the requirement for an election allows petitioner to create groups and elect from such groups. Although 37 CFR 1.143 only states that an election must be made, the context clearly indicates the election must be of one of the groups cited by the examiner. Petitioner’s interpretation would result in an applicant, after receiving a restriction requirement that lists 4 groups of 100 claims each, being able to simply create one group of 398 claims and another of group of 2 claims and elect the first group. A reading of the MPEP fails to indicate that petitioner’s interpretation should be given more weight than the Office’s interpretation of a rule drafted by the Office. An election must be an election of one of the groups/inventions cited by the examiner.

Petitioner did not file a complete reply. Specifically, petitioner did not make a provisional election any of the inventions/species cited by the examiner.

The failure to file a complete reply to a non-final Office action normally results in abandonment. However, 37 CFR 1.135(c) provides,

When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

If the reply to an Office action fails to satisfy the criteria set forth in 37 CFR 1.135(c), the application is abandoned and the examiner does not have the discretion to set a new time period for an applicant to reply. The MPEP 714.03 states,

The practice set forth in 37 CFR 1.135(c) does not apply where there has been a deliberate omission of some necessary part of a complete reply; rather, 37 CFR 1.135(c) is applicable only when the missing matter or lack of compliance is considered by the examiner as being "inadvertently omitted." For example, if an election of species has been required and applicant does not make an election because he or she believes the requirement to be improper, the amendment on its face is not a "bona fide attempt to advance the application to final action" (37 CFR 1.135(c)), and the examiner is without authority to postpone decision as to abandonment.

In this case the failure to elect one of the species was not an inadvertent omission. Petitioner made a conscious decision not to elect from the species listed by the examiner. Therefore, the examiner was required to hold the application abandoned.

Even if a reply satisfies the criteria set forth in 37 CFR 1.135(c), the application may still be held to be abandoned. MPEP 714.03 states, with emphasis added, "37 CFR 1.135(c) authorizes, *but does not require*, an examiner to give the applicant a new time period to supply an omission." An examiner may set a new time period for response, but is not required to take such a step. Petitioner has failed to prove the examiner abused his discretion by not setting a new period after petitioner chose not to file an election despite the examiner informing petitioner in the Office action that a response would be considered both nonresponsive and incomplete unless it was accompanied by an election.

For the reasons above, the application became abandoned as of midnight on October 25, 2003, and the holding of abandonment is not withdrawn.

#### The petition under 37 CFR 1.137(b)

A grantable petition under 37 CFR 1.137(b) must be accompanied by:

- (1) the required reply,
- (2) the petition fee,
- (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, and
- (4) a terminal disclaimer and fee if the application was filed on or before June 8, 1995 or if the application is a design application.

The instant petition lacks item (1). A proper reply to the September 25, 2003 Office action has not been filed. Petitioner may seek reconsideration of the restriction requirement. For example, petitioner might state the claimed inventions are obvious over each other within the meaning of

35 U.S.C. 103, and therefore restriction should not be required.<sup>1</sup> However, a reply to be complete, must be accompanied by a provisional election.

Since a proper reply has not been filed, the petition to revive cannot be granted.

Petition to make special

Petitioner requests a decision on the petition to make special filed October 20, 2003. Petitioner may wish to note that the Office is unable to accord special status to an application which is abandoned since such an application is not examined. Upon the revival of the application, the petition to make special will be referred to the Technology Center.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. No further petition fee is required for the request. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)."

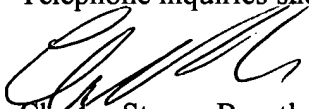
Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

By facsimile: (703) 872-9306  
Attn: Office of Petitions

If a request for reconsideration is filed, and a decision on the new petition is not received within three months, petitioner may wish to call the number below to check on the status of the renewed petition.

Telephone inquiries should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.

  
Charles Steven Brantley  
Petitions Attorney  
Office of Petitions

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<sup>1</sup> MPEP 803 states, "If there is an express admission that the claimed inventions are obvious over each other within the meaning of 35 U.S.C. 103, restriction should not be required. *In re Lee*, 199 USPQ 108 (Comm'r Pat. 1978)."